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Paper No. 19
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re X Technology, Inc.

Serial No. 75/229,690

John R. Hlavka of Watts Hoffmann Fisher & Heinke Co., L.P.A.
for X Technology, Inc.

LaVerne T. Thompson, Trademark Examining Attorney, Law
Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

X Technology, Inc. seeks to register this mark:



(with the wording, X TECHNOLOGY INCORPORATED, disclaimed)

for services having an amended recitation as follows:

"advertising of personal computers, personal computer
monitors, mother boards, modems, random access memory for
personal computers, computer supplies, multimedia components
for personal computers and parts for personal computers, on

a website, in mail order related magazines and in magazines directed to personal computers," in International Class 35.¹ Following publication of the mark for opposition and issuance of the notice of allowance, on August 13, 1999, applicant submitted a Statement of Use accompanied by specimens consisting of labels used on goods.

The new Trademark Examining Attorney assigned to review the Statement of Use issued a final requirement for the submission of a substitute specimen showing use of the mark in connection with the services identified in the application. The Trademark Examining Attorney contends that while the specimens of record show use of the mark in connection with goods, and perhaps even in connection with the sale of computers and computer peripherals, there are no specimens showing use of the mark in conjunction with advertising services for others.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing.

¹ Application Serial No. 75/229,690 was filed on January 22, 1997 by Quark Technology, Inc., based upon applicant's allegation of *bona fide* intention to use the mark in commerce in connection with the identified services. The official name change to "X Technology, Inc." was recorded in the Assignment Branch of the United States Patent and Trademark Office at Reel 1777, Frame 0269.

When this intent-to-use application was originally filed, applicant recited its goods/services as "computer equipment, computer peripherals, multimedia kits, retail, wholesale and mail order sales of computer hardware, and computer related information services, namely, advertising and promoting of computer related equipment, computer peripherals and multimedia kits on an internet website," in International Class 7 (sic). In the initial Office action, the Trademark Examining Attorney explained a number of reasons why the above formulation was unacceptable. In two successive amendments, applicant amended the recitation of services, appearing to limit the recital of services to the "advertising of personal computers ... " language listed above.

Following publication, applicant submitted its Statement of Use with labels as its specimen of use. They are a fairly exact representation of the mark as shown in the drawing. However, because they appeared to be labels used on goods, the Trademark Examining Attorney refused them as unacceptable for the recited services. Applicant then submitted copies of its Web pages as well as a copy of a two-page advertisement that appeared in the January 1997 issue of Computer Shopper. The Trademark Examining Attorney rejected the Web pages and these advertisements as well,

noting that they did not show the applied-for mark being used in connection with advertising services for others.

The Examining Attorney contends that while the Web pages and advertisements may demonstrate that applicant is offering retail or mail-order services under the applied-for mark, that is not the same as, or encompassed by, the services as specified in the amended recitation of services, and that applicant is limited in this application to a recitation of services encompassed by the amended recitation of record.

On the other hand, applicant contends that it now finds itself in a "Catch 22" situation. Applicant's intention throughout was to obtain a registration for its mark used in its own wholesale and retail sales of computers and computer peripherals through mail order and on-line contacts.

Applicant claims that in trying to follow the suggestions of the original Trademark Examining Attorney, it now discovers that its recital is limited to advertising services for others, a service it does not provide. In fact, applicant contends that factually, the Trademark Examining Attorney's conclusion is an arbitrary one, as nowhere does its recital mention "advertising services" directed to third parties.

Applicant contends, essentially, that it is manifestly unfair of the Office to require a more specific recitation

of services prior to applicant's submission of its specimens and Statement of Use, and then to reject the specimens in view of the limited recitation of services.

We find that logically, the amended recital, to be given any meaning at all, must be read to refer to advertising services provided for the benefit of others. As argued by the Trademark Examining Attorney, advertising one's own goods or services is simply not a recognized service under the Lanham Act. See In re Reichhold Chemicals, Inc., 167 USPQ 376 (TTAB 1970).

As originally filed, the broad listing of goods and/or services was quite ambiguous. In the initial Office action, the Trademark Examining Attorney provides various suggestions on changing the identification of goods and/or recital of services. Being an Intent-to-Use application, the Trademark Examining Attorney had no specimens to guide her in offering suggestions. However, she made suggestions for amending the identification of goods and/or recital of services to acceptable language for goods (computers and peripherals) classified in International Class 9; for retail, wholesale and mail order catalogue services featuring computers and peripherals, etc., classified in International Class 35; or advertising services for others, also classified in International Class 35. With hindsight,

it appears as if applicant, with its amendment of March 1998, should have adopted the identification of goods in International Class 9 (if the applied-for mark is actually used on labels affixed to the hardware or containers), or a recital of services naming mail order catalogue services, in International Class 35.

Regarding applicant's argument, our rules and precedent clearly require us to consider the recitation of services as amended. See Trademark Rule 2.71(a) and In re Swen Sonic Corp., 21 USPQ2d 1794 (TTAB 1991). In this regard, we point out that at the time the recitation of services was amended, the application contained no specimens of use and only applicant was in a position to know the nature of the goods or services upon which it intended to use the mark. It was applicant's responsibility to set forth an amendment to its identification of goods or its recitation of services that accurately reflected its intended use of the mark.

Hence, we conclude that nowhere do the labels, the Web site or the magazine advertisements show use of the applied-for mark as a service mark for the recitation of services as amended, e.g., advertising of personal computers, etc.

Decision: The refusal is affirmed on the ground that the Trademark Examining Attorney properly required substitute specimens for the identified services.